

Application Serial No.: 09/856,147
Amendment dated August 13, 2003
Reply to Office Action dated February 13, 2003

REMARKS

Favorable reconsideration of this application, in light of the present amendment and the following discussion, is respectfully requested.

Claims 1, 3, 5-9, 11, and 12 remain pending in this application, Claims 1, 3, 5-9, and 11 having been amended, Claims 2, 4, and 10 having been canceled, and Claim 12 having been added by the present amendment.

In the outstanding Office Action, it is alleged that the application does not contain an abstract of the disclosure, the disclosure is objected to because of certain informalities, Claims 1-11 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite, Claims 1, 10, and 11 were rejected under 35 U.S.C. § 102(b) as being anticipated by *European Patent Application Publication No. 0 449 316* (hereinafter "*EP '316*"), Claims 2 and 4-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *EP '316* in view of *the Background Art section of the specification on replacement sheet 1, line 5 through replacement sheet 3, line 8* and *Shiga et al.*, and Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *EP '316* in view of *the Background Art section of the specification on replacement sheet 1, line 5 through replacement sheet 3, line 8* and *Hall et al.*, and Claims 1, 2, and 6-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Zahora et al.* in view of *EP '316*.

Applicant respectfully traverses the Office Action's allegation that the present application does not contain an abstract of the disclosure as is required by 37 C.F.R. § 1.72(b). An Abstract can be found as part of the original disclosure on page 8 of the specification. However, Applicant has amended the Abstract to correct certain informalities.

Application Serial No.: 09/856,147
Amendment dated August 13, 2003
Reply to Office Action dated February 13, 2003

Applicant respectfully submits that the amendments to the Abstract do not add new matter. Based on the foregoing, Applicant respectfully requests withdrawal of the allegation that the present application does not contain an abstract of the disclosure.

The specification has been amended on replacement sheet 3, lines 5 and 6 in order to change the first occurrence of the word "wiping" to "dipping," to delete the word "conf.," and to change "page 10, lines 7-10" to "(see EP0044144, page 10, lines 7-10)" for clarity as to what reference the page and line numbers are referring. Accordingly, the Applicant requests the withdrawal of the objection to the disclosure.

Claim 1 has been amended in a manner similar to the suggestion on the bottom of page 2 of the Official Action. The phrase "an additional surface layer" has been removed from Claim 1. Additionally, the claims have been amended to correct the spelling errors and antecedent basis problems noted on page 3 of the Official Action. Accordingly, the Applicant respectfully requests the withdrawal of the indefiniteness rejections of the claims.

Regarding the art rejections, Claim 1 has been amended to recite a method of producing a high T_c superconducting tape or wire, where the method comprises the steps of providing a superconducting core, placing a metal sheath around the superconducting core, performing a plurality of annealing steps, and after a final annealing step, applying a surface layer to the wire or tape, where the surface layer includes an electrical insulating layer provided on the metal sheath and a low friction layer provided on the electrical insulating layer. The Applicant submits that such a method is not disclosed or suggested in the cited references, either when taken singularly or in combination.

Application Serial No.: 09/856,147
Amendment dated August 13, 2003
Reply to Office Action dated February 13, 2003

The subject matter of Claim 4 has been incorporated into Claim 1. The only rejection that was cited against Claim 4 is the obviousness rejection combining EP '316 in view of the Background Art section of the present application and Shiga et al. The Applicant begins by noting that none of these references disclose or suggest applying, after a final annealing step, a surface layer to the wire or tape, where the surface layer includes an electrical insulating layer provided on the metal sheath and a low friction layer provided on the electrical insulating layer. As noted in the Official Action, EP '316 does not disclose or suggest applying an electrical insulating layer, nor does EP '316 disclose or suggest applying a low friction layer, nor does EP '316 disclose or suggest applying more than one layer after the final annealing step. In fact, the remaining references also fail to supplement the deficiencies in EP '316 by, for example, failing to disclose or suggest providing both an electrical insulating layer and a low friction layer after the final annealing step.

Accordingly, the Applicant respectfully requests the withdrawal of the art rejections of claim 1.

Thus, the Applicant submits that Claim 1 is in condition for allowance.

The Applicant notes that Claims 3, 5-9, and 11 are either directly or indirectly dependent upon amended Claim 1, and thus the arguments serving to patentably distinguish amended Claim 1 from the prior art of record are available, among others, to patentably distinguish Claims 3, 5-9, and 11.

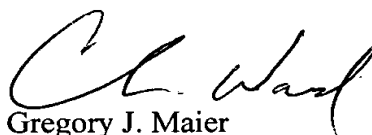
Application Serial No.: 09/856,147
Amendment dated August 13, 2003
Reply to Office Action dated February 13, 2003

Newly added Claim 12 is considered allowable as it recites features of the invention that are neither disclosed or suggested by the references of record.

In view of the foregoing, Claims 1, 3, 5-9, 11, and 12 are believed to be in condition for allowance, and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Registration No. 25,599
Attorney of Record

Christopher D. Ward
Registration No. 41,367



22850

Customer Number 22850
Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 10/01)

GJM:CDW:brf
I:\atty\cdw\208473US3 PCT\am1.doc